

Attorney Docket No.: **PENN-0882**
Inventors: **Dreyfuss and Wang**
Serial No.: **10/532,203**
Filing Date: **January 9, 2006**
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REMARKS

Claims 1-8 are pending in this application. No new matter has been added. Applicants are respectfully requesting reconsideration of the species election requirement in view of the following remarks.

The reply filed November 17, 2008 has been suggested as not being fully responsive to the Restriction Requirement of record. The Examiner suggests that Applicants failed to correctly elect a particular compound of Formula II.

As discussed in a telephonic interview with the Examiner on December 3, 2008, Applicants' reply filed November 17, 2008 recited an elected species that meets the requirements under PCT Rule 13.2, namely Formula II. Therefore, an agreement with respect to the Examiner's request to orally elect a single compound of Formula II was not reached in the interview.

Indeed, Applicants respectfully disagree and traverse this species election requirement because it is not procedurally proper under National Stage filings of International Applications. The present case is the National Stage filing of PCT/US03/33022. Thus, this application is to be considered under 35 U.S.C. 371, PCT Rule 13.2, 37 CFR 1.475 and Chapter 10 of the ISPE Guidelines. Chapter 10.17 of the ISPE Guidelines states:

Rule 13.2 also governs the situation involving a single claim that defines alternatives (chemical or non-chemical), the so-called 'Markush practice.' In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, is considered met when the alternatives are of a similar nature.

(a) When the Markush grouping is for alternatives of chemical compounds, they are regarded as being of a similar nature where the following criteria are fulfilled:

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(A) all alternatives have a common property or activity, and

(B)(1) a common structure is present, that is, a significant structural element is shared by all of the alternatives, or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

(b) In paragraph (a)(B)(1), above, the words "significant structural element is shared by all of the alternatives" refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art, and the common structure is essential to the common property or activity. The structural element may be a single component or a combination of individual components linked together.

(c) In paragraph (a)(B)(2), above, the words "recognized class of chemical compounds" mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

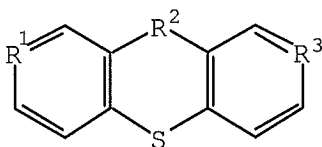
(d) The fact that the alternatives of a Markush grouping can be differently classified is not, taken alone, considered to be justification for a finding of a lack of unity of invention.

(e) When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention should be reconsidered by the examiner. Reconsideration does not necessarily imply that an objection of lack of unity will be raised.

In this regard, Applicants respectfully submit that alternative compounds of Formula II share the common property or activity of replacing or enhancing the function of SMN. Thus, the alternative compounds of Formula II meet the requirement set

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forth in Section 10.17(a)(A) of the ISPE Guidelines. In addition, alternative compounds of Formula II share a significant structural element, namely that depicted in Formula II, thereby meeting the requirement set forth in Section 10.17(a)(B)(1) of the ISPE Guidelines.

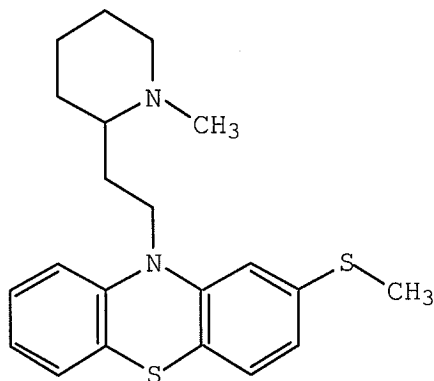


Formula II

Thus, it is respectfully submitted that the alternative compounds of Formula II meet the requirement under PCT Rule 13.2. Accordingly, reconsideration of this species election requirement is respectfully requested.

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However, in an earnest effort to be completely responsive, Applicants hereby elect, with traverse, to prosecute the species of:



Compound 17.

Respectfully submitted,

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